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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/988,347  | 11/19/2001  | Yuichiro Ogawa       | 109808              | 8515             |
| 25944   | 7590        | 07/01/2004           |                     |                  |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 19928<br>ALEXANDRIA, VA 22320 |             |                      |                     |                  |
| EXAMINER<br>KNABLE, GEOFFREY L                                  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |

1733

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/988,347

Applicant(s)

OGAWA ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1733

1. New claim 12 relates to a new grouping (i.e. IV) that is distinct from those previously claimed (and therefore also from elected group I) for the following reasons.

2. The inventions of new claim 12 (group IV) and groups I/II are related as a method characterized by a combination of features (i.e. new claim 12 combines claims 1 and 5 from groups I and II) and methods characterized by subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the separate presentation of independent claims in groups I and II (which are combined in new claim 12) provides evidence that the sole distinguishing novelty in the combination does not rest with the particulars of either subcombination. The subcombinations have separate utility such as in methods not combined with the other subcombination (i.e. each alone or in other combinations).

3. Applicant's election with traverse of group I, claims 1-4 in the reply filed on 4-5-2004 is acknowledged. The traversal is on the ground(s) that a search for one would encompass a search for all and further that new claim 12 is a linking claim. This is not found persuasive because the separate and distinct parts of the tires that are being formed in each method grouping present significantly different considerations in search and examination such that a serious burden

would be presented to search/examine each in the same application.

Additionally, claim 12 is considered to be a combination claim rather than a linking claim.

It is noted however that rejoinder of a combination claim such as claim 12 will be considered if appropriate at that time upon indication of allowable subject matter.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 5-7 and 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4-5-2004.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Landsness (US 4,279,683) or DE 19831747 to Continental as applied in the last office action.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-109506 to Sumitomo Rubber as applied in the last office action.

8. Applicant's arguments filed 4-5-2004 have been fully considered but they are not persuasive.

In light of applicant's arguments, the 35 USC 112, second paragraph rejection is withdrawn.

As to the prior art rejections, the rejection with respect to Holroyd et al. has also been withdrawn in light of applicant's response.

As to Landsness, it is argued that this reference does not suggest radially outwardly expanding the carcass. The examiner however still maintains that it was considered to have been suggested or in any event certainly obvious to form the toroidally shaped carcass in this manner for reasons set forth in the statement of rejection, it again being stressed that building tires cylindrically followed by toroidal shaping/expansion is *extremely common, well known and the typical* (and therefore obvious) manner in which tires are built. In response to this, applicant has asserted that "no applied references can be combined with Landsness to suggest, or show motivation for, the specific combination of features recited in independent claim 1." It is not clear if applicant is challenging the well known nature of toroidal shaping or whether it is being asserted that it is not explicit in Landness. Again and in any event, such typical toroidal shaping is even alluded to in Landsness at col. 1, lines 34-38. Further, it would have been readily apparent that the carcass that is being wound upon in Landness is *not* a cylindrical carcass but rather has been shaped - e.g. note esp. fig. 2, 5 and 6, it being considered that the ordinary artisan would have understood from the reference teachings that this is formed in typical manner including the standard two stage building which involves a toroidal or "radially outward" expanding step to achieve the illustrated shape.

As to DE to Continental, it is argued that this reference does not disclose or suggest radially outward expanding a cylindrical carcass. This argument has

been carefully considered but is unpersuasive. It is first again noted that this reference clearly indicates and illustrates that the carcass upon which the sidewalls are wound has an expanded shape. The ordinary artisan would have understood that this can occur essentially two ways - either by building the tire carcass cylindrically and "radially expanding" the center part or by building the entire tire in the toroidal shape. Either expedient is well known and conventional in this art but it is in any event considered that DE '747 is suggesting an expansion and thus would have been understood as implicitly suggesting (or certainly rendering obvious) the typical tire building in which the carcass is expanded from cylindrical form. Note also in particular that col. 8, lines 14-17 of DE '747 discloses (by internet translation (google.com)) "The tire blank is bombiert(?) here on a building block machine 29 provided with swivelling structure drum over interior bellows subjectable with compressed air and strained," this reference to the use of a bellows that is inflated further supporting the examiner's position in this regard (it is believed that this is defining the typical shaping/expansion process and would have been understood as such by the ordinary artisan).

As to JP '506, it is argued that this reference does not disclose radially outward expanding a widthwise center portion of a cylindrical band apparently because it is not shown in fig. 3A. Fig. 3A however simply represents the extremely common and typical tire carcass building and carcass turn-up steps (i.e. turning-up the axial ends of the carcass around the beads as is of course typical) that form the cylindrical carcass. The toroidal shaping or "radially

outward expanding" that **must necessarily follow** is clearly illustrated in fig. 3B as noted in the last office action. Applicant's arguments are therefore unconvincing and not entirely understood in light of the clear disclosures in the reference.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
June 26, 2004